

Remarks

Claims 1-6 are in the application, of which claims 1, 4, and 5 are in independent form.

Claims 1-6 are subject to restriction under 35 U.S.C. § 121. Claims 1-6 also stand rejected under 35 U.S.C. § 103(a).

In the specification, paragraph [0012] is amended to mention in the text of the description reference numerals 112' and 116' shown in FIG. 3. Paragraph [0013] is amended in accordance with the examiner's suggestion to change "second tensioning member 120'" to "first tensioning member 120'."

Claim 5 is amended to delete redundant and unnecessary language, to thereby correct an obvious claim drafting error, without adding new matter or narrowing the claim.

Restriction under 35 U.S.C. § 121

Claims 1-6 stand subject to restriction under 35 U.S.C. § 121. The Examiner has identified two species, as follows:

Species 1 – depicted by FIGS. 1 and 2; and

Species 2 – depicted by FIG. 3.

Applicant confirms the provisional election of Species 2 for prosecution, with traverse, and respectfully requests reconsideration. Applicant contends that claims 1-6 are readable on the elected species.

The Office action states that no claim is generic. Applicant disagrees and asserts that claims 1 and 3-5 are generic to both species identified.

Applicant believes the restriction requirement is improper because the Office action includes no rationale for restriction or the examiner's conclusion that the claims are directed to patentably distinct species, as is required by MPEP § 803 ("Examiners must provide reasons and/or examples to support conclusions . . ."). See also, MPEP § 816 ("A mere statement of conclusion is inadequate."). Furthermore, applicant contends that it would be unreasonable to reach such a conclusion in this case.

Rejections under 35 U.S.C. § 103(a)

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,532,981 of Wolfe ("Wolfe"). Claims 1-6 also stand rejected as being unpatentable over Wolfe in view of U.S. Patent No. 6,442,843 of Jue et al. ("Jue"). Applicant respectfully traverses these grounds for rejection and requests reconsideration.

With respect to claims 1, 4, and 5, Applicant respectfully contends that Wolfe does not disclose substantially all of the claim limitations. Claims 1 and 4 both recite a sliding

member and a tensioning member that biases the sliding member “in a direction such that when the apparatus” is “mounted to a chain saw having a mounting stud, *the sliding member is biased towards the mounting stud.*” (emphasis added). Claim 5, as amended, recites a sliding member and a first tensioning member that “*biases the sliding member towards the mounting stud*”. (emphasis added). Wolfe does not teach or suggest an apparatus with a sliding member “biased towards the mounting stud,” and therefore Applicant contends that claims 1, 4, and 5 are not unpatentable over Wolfe alone, or over Wolfe in view of Jue.

Wolfe teaches sliding member 25 that is adjacent to a first tensioning member 40. When mounted to a chain saw 22 having a mounting stud, the first tensioning member 40 does bias the sliding member 25, but it does so in a direction opposite the location of the mounting stud. As depicted in FIGS. 1 and 2, the sliding member 25 is located near the tip of the chain saw 22 and the first tensioning member 40 is located between the sliding member 25 and the mounting stud. As such, the first tensioning member is only able to bias the sliding member in a direction opposite the mounting stud. In contradistinction, claims 1, 4, and 5 recite a sliding member biased “towards the mounting stud.” Wolfe does not teach this limitation. Moreover, due to the arrangement of the device of Wolfe, reversal of the direction of biasing would defeat the purpose of the sliding member 25 thereof and render it inoperable, in that the saw chain would no longer be tensioned. Therefore, the Office action fails to make out a prima facie case of unpatentability. Applicant respectfully requests that the rejections of claims 1, 4, and 5 be withdrawn. Because claims 2, 3 and 6 all depend from claims 1 and 5, and include additional limitations, applicant respectfully requests that the rejections of claims 2, 3 and 6 also be withdrawn.

With respect to claims 2 and 6, the Office action asserts that Jue teaches a plurality of recesses in the sliding member, that enable the sliding member to be ratcheted away from the mounting stud in step-like fashion. The Office action identifies notches 32, 34 of Jue as corresponding to the claimed recesses. However, the Office action fails to identify where in Jue it is taught or suggested that these notches cooperate with any other parts (such as latch member 22) for ratcheting in step-like fashion. Applicant is unable to identify in Jue any such teaching of ratcheting. Therefore, applicant asserts that the Office action fails to make out a prima facie case of unpatentability of claims 2 and 6 and requests that the rejection be withdrawn.

Conclusion

Applicant believes the application is in condition for allowance and respectfully requests the same. Applicant invites the examiner to contact the undersigned by telephone, in the event that the examiner believes there are any issues outstanding.

Respectfully submitted,

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